#19 Response w/ Ext. (3 mos) 1/17/02 $ 3713

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the CPA Patent Application of

MURASAKI et al.

Cofm 1/17

Parent Application:

Examiner: J. Hotaling

Art Unit: 3713

Serial No.: 08/828,417

Docket No.: P-9702 CON

Date Filed: March 28, 1997

For: Speech Generating Device and Method in Game Device and Medium for Same

Commissioner of Patents
Washington, D.C. 20231

RESPONSE

SIR:

This is in Response to the Office Action Mailed May 9, 2001.

An extension of time to respond to the Office Action is requested and a check to cover the fee is enclosed.

Claims 23-28, 31 and 34-44 have been rejected as being obvious on the basis of a large number of references, namely Murata '743 as the primary reference when taken with the teachings in the following secondary references: Lowe et al '401, Best '073, Best '152 and Cookson et al '950, for reasons set forth in paragraph 1 of the Office Action. The rejection in the Office Action is based on

the identical combination of references relied on by the Examiner in the Office Action dated July 5, 2000. Following the Office Action of May 9, 2001 the undersigned attorney for Applicant has a few telephone conferences with the Examiner during which the Office Action, references and the claims were discussed. The Examiner's time during such conferences is appreciated.

Because the references cited are identical to the references previously cited the arguments previously submitted in the Amendments mailed April 10 and December 14, 2000 are incorporated herein so that they need not again be repeated.

Even if Murata '743 discloses what the Examiner alleges, the Examiner concedes at page 4 that it lacks any disclosure regarding the provision of "alternate language commentary" and other features. Yet, in discussing each of the secondary references nowhere does the Examiner suggest that any of the references teaches or suggests such a feature. Each of the independent claims of record, claims 23, 34 and 35, all require that the databases contain phrases which are "equally appropriate for a specified predetermined condition." What this means is fully discussed in the application and has been discussed at length in the

previous responses and during conferences with the Examiner.

On page 3 of the Office Action, the Examiner directs Applicants' attention to Murata '401, column 5 line 17 to column 6 line 24 for the teaching of a video game that uses "alternative phrases". However, for reasons previously discussed, this passage merely teaches the use of phrases that may be appropriate for a given play but this is precisely the prior art which Applicants have sought to improve. The use of the identical phrase (e.g. "BATTER OUT") each time that the event occurs (batter is out) renders the game boring or tedious after a period of play. The invention is intended to use *alternative equally appropriate* phrases for the *same* play.

The Examiner then relies on Lowe et al, stating at page 5 of the Office Action, that this reference may be relevant. However, the Examiner concedes that the reference merely allows audio play by play commentary to be selectively muted and the audio to be replaced with *an audio insert that may be either silence or sound such as music or a commercial.* This is clearly intended to simulate the audio environment normally encountered when watching a football game. The patentee suggests that when the video format is Laser Video Disk it is possible to

use two audio tracks that share common frame numbers. However, this is simply a statement of well known technology and does not even remotely teach or suggest the use of two or more data bases that each includes command data that represents a plurality of phrases that may be related and are equally appropriate for specified or predetermined conditions or events during a video game. Fig.2 of Lowe et al '401 shows one video medium 12 and one audio medium 14 that are intended to allow a user to interact, as noted, with what appears to be an actual televised football game. It is obvious that the purpose for the multiple audio tracks for each video frame is to allow the system to provide more than one track of audio during the progress of the game, such as an announcer's voice, music, cheering of the crowd, etc. No suggestion whatsoever of the invention as defined in the claims and clarified to the Examiner on numerous occasions.

Reliance on the Best patents for the teaching of audio clips switched to provide multiple story plots to make the system less predictable again missed the point. The present invention is for a video game and not to a system for playing unpredictable story plots.

Not finding a reference that teaches or suggests the invention as defined in

the claims of record, the Examiner resorts to simply alleging that it would be obvious to use two announcers and to have multiple announcers for commenting on a game. During, one of the telephone conferences with the Examiner he indicated that he has been playing video games since he was a young child and that it is old to use multiple announcers in video games. The Examiner's assertion may be true. However, it is believed to be unreasonable for the Examiner to rely on his life experiences as a basis for the rejection. Applicant should be allowed to respond to a written record. If the Examiner relies on his life experiences, in whole or in part, in making the rejection this should be set forth in greater detail in the Office Action and possibly supported by a formal statement. Such is respectfully requested.

It is clear that the Examiner has simply tried to reconstruct the invention by using the hindsight of the present application and the teachings contained therein by picking and choosing references that the Examiner has felt contained "pieces" of the invention. However, even with such hindsight reconstruction the combination of all the references still fails to teach or suggest the invention. Further "inventive" modifications to the proposed combination would still need to

be made and, as before, there is simply no demonstration that there would be any motivation to do so. For the Examiner to suggest that the motivation comes from the references because they all teach the selective use of audio in video games is unreasonable for a number of reasons. If the broad use of audio in video games was a motivation to suggest the invention the same can be said of the other references. Once the first patent issued none of the others should have issued since the motivation was there to conceive all the further improvements or modifications that were, in fact, patented. Furthermore, the Examiner's argument might be somewhat credible if the proposed combination in fact resulted in the claimed invention. However, as noted, it does not even come close. Where does the additional motivation come from? It is respectfully submitted that is can only have come from the instant application.

It is believed that this application is in condition for allowance. Early allowance and issuance is, accordingly, respectfully solicited.

Dated: November 9, 2001

Respectfully submitted,

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MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the United States Postal Services as Express Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on the date indicated below:

Myron Greenspan
Attorney's Name

_____
Signature

November 9, 2001
Date

Applicant hereby petitions that any and all extensions of time of the term necessary to render this response timely be granted. Costs for such extension(s) and/or any other fee due with this paper that are not fully covered by an enclosed check may be charged to Deposit Account #10-0100.